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Supreme Court of the United States

October Term, 1938

THE SCHEIDT-SCHMIDT COMPANY,
Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CINCINNATI CORPORATION,
Respondents.

No. 3

THE AMERICAN MOTOR SUPPLY COMPANY,
Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CINCINNATI CORPORATION,
Respondents.

No. 4

THE F. E. BOW'S SALES COMPANY,
Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CINCINNATI CORPORATION,
Respondents.

No. 5

PETITIONERS' REPLY BRIEF

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IN THE
Supreme Court of the United States
October Term, 1938

THE ~~SCHROEDER~~ SCHROTH COMPANY,
Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.

No. 3

THE ABERDEEN MOTOR SUPPLY COMPANY,
Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.

No. 4

THE F. E. ROWE SALES COMPANY,
Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.

No. 5

PETITIONERS' REPLY BRIEF.

Respondents' brief is divided into two sections, but they seem to cover exactly the same subject matter. We shall not attempt to answer these sections separately, but will answer the brief as a whole, with reference to the points in petitioners' brief.

Point I.

As we understand it, respondents' answer to petitioners' Point I is, (a) that the Court of Appeals did not hold that a flexible web was an essential element of the Gulick patent; (b) that the amendment which was made in the Gulick specification five years after it was filed and after the Long pistons came on the market was justified because of the alleged "inherent" lateral flexibility of the Gulick webs; (c) that the *dimensions* of the webs on the *drawings* of the Gulick patent, if followed, would produce webs laterally flexible; and (d) that the decisions of this Court in *Permutit v. Graver* and *Powers-Kennedy v. Concrete* are distinguishable from the case at bar. We will answer these propositions in the order in which we have stated them.

(1) As will be apparent from a reading of the opinion of the Circuit Court of Appeals, Gulick came into a crowded art. As the Circuit Court of Appeals said (R. 2385):

"The Gulick patent is for a combination of elements, many, if not indeed *all of which*, are to be found in the prior art."*

The Circuit Court of Appeals then went on to describe the Gulick device and said:

"That Spillman and Mooers patent 1,092,870, and Franquist patent 1,153,902, showed air gaps between piston head and skirt, or that splitting the piston skirt vertically or combining the vertical and longitudinal splits into the so-called T-slot were old practices, is not conclusive on the question of invention."

* Where italics are used in quotations, it will be understood that the emphasis is ours unless otherwise noted.

In order that this statement may be understood, we pause to briefly describe these two prior art devices. The Spillman and Mooers piston had the head completely separated from the skirt just as in the Gulick patent. It provided the same means as in the Gulick patent for holding them together and supporting the wrist pin bosses. To quote the language of the Circuit Court of Appeals:

"The wrist pin bosses are pulled inwardly from the skirt periphery, and instead of being supported by the skirt are carried from the piston head by depending flanges, thus providing a *vertically rigid* support for the bosses. * * *"

A drawing of this piston will be found in R. Vol. III, p. 1684. A cross-section model is in evidence as Exhibit 3-P. This patent, however, did not disclose a vertical slit. The Franquist patent (R. Vol. III, p. 1688), a drawing of which appears in an appendix to our main brief, had four grooves or as the patent calls them "slots," which serve the same purpose as the slit and had two air gaps between the head and the skirt, exactly as in the *accused* device, and wrist pin bosses pulled inwardly from the skirt. A vertical slit, as found by the Master and conceded by the Circuit Court of Appeals, was old. The Master said (R. Vol. II, p. 1154):

"Slotting through piston skirts was not only old, as shown by the Ebbs patent of 1902, the Van Bever, Rainforth and Serex patents of 1912 and the Vincent patent of 1913 * * * " etc.

The Serex patents (R. Vol. III, p. 1779) show a T-slot. The Circuit Court of Appeals then went on to describe and define the Gulick invention as follows (R. 2386):

"To decelerate the flow of heat from piston head to skirt by an air gap was perhaps an obvious expedient

in the art.* To slit the skirt vertically so that pressure of the cylinder wall would compensate for thermal expansion was perhaps not beyond expected skill in the art.** Minute relief of the cylinder periphery in the region of the bosses was shown in Franquist.*** But to *combine* the insulation of head from skirt, retraction of the bosses from the skirt periphery, connection of such bosses to the skirt *with webs laterally flexible* and yet so carried from the head as to support the load upon the wrist pin with sufficient strength and rigidity, and to utilize the mechanical force of the cylinder wall upon the skirt and the thermal expansion of the bosses so as to compensate evenly and fully for head expansion and to secure a *balanced flexibility of the skirt* with no bending concentration at any point therein, discloses, we think, a meritorious concept beyond the reach of those skilled in the art."

We think it is apparent from the above quotation that the Circuit Court of Appeals considered that one of the main elements of the Gulick invention, if not the most important one, was "webs laterally flexible and yet so carried from the head as to support the load upon the wrist pin with sufficient strength and rigidity". That is the only element which the Circuit Court of Appeals did not refer to as either in the prior art or as within the expected skill of the art. Such a web was shown in the Spillman and Mooers patent although not described as laterally flexible.

* This, as previously shown, was not only obvious but was old in Spillman and Mooers and Franquist.

** This was old in the patents referred to in the part of the Master's report above quoted. In the interference proceedings involving the Gulick application, the Law Examiner was of the same opinion regarding the non-inventive character of splitting the skirt as the Circuit Court of Appeals (R. Vol. III, p. 1660).

*** The same relief as is in Gulick is shown in Spillman and Mooers.

It is, of course, a settled rule that all elements of the claims of a patent must be considered as essential and it certainly cannot be presumed that the Circuit Court of Appeals, when it referred to the flexible web as an "element" of the combination in which the invention of the patent was found, did not treat it as an *essential* element.

(2) The Circuit Court of Appeals rested its conclusion regarding the propriety of the amendment to the Gulick specification in respect to the webs upon two decisions in interference proceedings in which the Gulick application was involved (*Long v. Gulick*, 17 F. [2d] 687; C. A. D. C.; *Hartog v. Long v. Gulick*, 47 F. [2d] 365, 367, C. C. P. A.). In these cases it was contended that Gulick could not make the claims there involved. It was held that he could, the reasoning being that, in view of the slit in the skirt, the purpose of the invention would fail unless the webs were made to yield. In *Long v. Gulick*, the Court said in addition:

"The *drawings of Gulick*, we think, clearly disclose the structure of the count."

The courts in those cases, and the Circuit Court of Appeals in the case at bar by adopting their reasoning, have therefore held that the web shown in the Gulick drawings must be inherently flexible, otherwise the slit would not work. But, as pointed out in our main brief,* respondents' expert in the case at bar testified that in order to procure flexibility, there "must be a correct proportioning of the different parts as to location and thickness" and that one "cannot rely upon the inherent flexibility of any given structure". Not only is there not a word in the specifications of the Gulick patent, as originally drawn, as to the lateral flexibility of the webs, but

* P. 33.

as pointed out in our original brief, they were directly to the contrary. Respondents' brief not only controverts this proposition, but confuses the "webs" 18 here in issue with the "webs" 20.* The webs 20 are of cross formation and connect the bosses 16 to the head 10. It is through these webs 20 that the power is transmitted from the piston head to the bosses and then to the connecting rod.** It is these webs 20 that the Court of Appeals decision described as

"providing a vertically rigid support for the bosses" (R. 2385).

But it is not the webs 20, but the webs 18 which connect the bosses with the skirt, and as to these the original specification stated (see appendix, petitioners' brief).

"Another object of the invention is to *rigidly* support the piston pin *bosses* of a piston from the piston *walls*" (p. 53).

"Provides an *extremely rigid* connection between the piston pin *bosses* and the *skirt*" (p. 53).

"Provide a particularly strong support for the bosses" (p. 56).

It is these webs 18 which were by the amendment described as having "lateral flexibility", and it is these webs 18 which the Court of Appeals decided permitted the bosses to have

"freedom of *lateral motion* in a direction at right angles to the thrust of the piston" (R. 2385)

and constituted a

"connection of such bosses to the skirt of the piston with webs *laterally flexible*" (R. 2386).

* See drawing in Appendix, p. 59, petitioners' brief.

** See illustration, respondents' brief, p. 43.

We therefore find that the "inherent flexibility" upon which the District of Columbia Courts and the Court of Appeals relied is (a) diametrically opposed to the statement in the Gulick specification as originally drawn; (b) it cannot, according to the respondents' own witness, be relied upon; and (c) it depends entirely upon circular reasoning, i. e., that if the webs were not flexible, the purpose of the invention would be defeated. This reasoning proceeds from a generic statement of a desired result to a specific statement of structure for producing such result. It might be that the skirt would contract at some place, but it would not follow that a particular part inside of the skirt, namely, a web, would flex laterally, particularly when the original specification stated that the web was to be "extremely rigid".

It is not proper to make out a disclosure under R. S. 4888 by speculation and deduction. A like argument was advanced in *Permutit v. Graver*. The argument was that because the patent described a stirrer for the zeolites within the container, that this showed that a "free" as distinguished from a "locked" bed was disclosed, because as the Court of Appeals in that case said "this feature was necessarily presupposed"; and further, that the patentee need not describe nor understand "a certain theory of operation" of a structure in the specification and drawings. But this Court said (284 U. S. 59):

"We think that these views rest upon misconception."

So here, in the Gulick original application the mere presence of a vertical split in the skirt, even if described as such, cannot be relied upon as disclosing "webs laterally flexible"—that "this feature was necessarily presupposed"

—certainly not when the original description was exactly the opposite, namely “an extremely rigid connection”.

This Court further said (pp. 59-60):

“But there is no suggestion on the drawing or elsewhere that the upper plate bearing the layer of sand or quartz has any purpose except to serve as a mechanical filter through which ‘the water to be softened may be first filtered’, or that the unoccupied space has any other purpose than that of similar spaces in sand filters long familiar.”

So here, there is no suggestion in the drawing or elsewhere that the webs connecting the wrist pin bosses with the skirt had any other purpose than similar webs in pistons long familiar, namely, the webs of the Spillman and Mooers patent.*

The question is—what was the invention with which Gulick came into the Patent Office? Of course, the best answer is his description in his specification.

(3) Respondent says that one can follow the dimensions on the drawings of the Gulick patent and secure “webs laterally flexible”, and that it is common for engineers to work from drawings. In the first place, this Court held in *Permutit v. Graver* that drawings cannot supply a deficiency in the specification. But, apart from that rule, this is not a case where the description in the original specification was silent and the drawing was one stated to be of actual dimen-

* The Master's finding 11 (R. 1098) is to this effect. See also his Report (R. 1155). This Spillman and Mooers patent was included in a suit against Sterling's customer, Simmons, resulting in a decree holding a piston like Exhibit 1 infringing this Spillman and Mooers patent, which Exhibit 1 was found by the Court of Appeals to infringe the Gulick and also the Maynard patent.

sions, so that those skilled in the art were told to follow the dimensions given. The drawings were conventional patent drawings which were not stated to be dimensional and which could not be legally considered as such. The specification did not even state whether the piston is to be of aluminum,* or of cast iron, or of steel,** although, these are different metals and require different dimensions. For that reason the drawings could not be relied upon where the specification is silent.

In order to show this Court the difference between a patent drawing giving no dimensions and an engineering drawing with its complete data, reference is first had to Plaintiff's Exhibit 21 (R. 1337). This is an actual engineering drawing of a piston, indeed probably the first engineering drawing of a piston of the Maynard patent. The first thing we see is dimensions in utmost detail with directions to take them at a "temperature of 70° Fahrenheit", and with the definite warning "NOTE—DO NOT SCALE THIS BLUE PRINT", which latter, of course, means do not pay any attention to the thicknesses and sizes delineated on the drawings, but strictly follow the dimensions indicated. Moreover, the nature of the material is given as "LYNITE" which is an aluminum alloy. Now in spite of all the pains that was taken in Exhibit 21, this piston apparently would not work, for no sale of a single piston has been shown (see discussion, petitioner's brief, pp. 40-41). We, therefore, next find Exhibit 22 (R. 1339) with a Keystone relief added at (H) with the notation "their wire". Here we find in addition

* Plaintiff's expert Dr. Jeffries admits that there is no disclosure in the Gulick patent, even as issued, that the piston is to be made of aluminum (R. 137).

** In 1917 pistons were made of cast iron (Schmiedeknecht R. 1306), and even of steel (Pugh R. 1744).

to the dimensions and warning given on Exhibit 21 also a specified "HARDNESS".

This should satisfy this Court that the drawing of the Gulick application was not a drawing on which any engineer would or could rely.

Respondents also contend that because the original Gulick application used the word "web" (even though originally described as "extremely rigid"), the application could be amended to describe the same web as "laterally flexible", because that was a "property" or something "inherent" in any "web". A dictionary definition of "web" (brief, p. 5) is given. What respondent has done was to quote the favorable and unanalogous definitions, and not the analogous ones which are the following, taken from a later edition of Webster's Universal Dictionary of 1937:

"(d) the plate or its equivalent in a beam or girder which connects the upper and lower flat or laterally extending plates (fig. 'b'); (e) the corresponding portion of a rail between the tread and foot (fig. c); (f) the flat portion of a wheel, as of a railway-carriage, between the nave and the rim, occupying the space where spokes would be in an ordinary wheel (fig. a); (h) that portion of an anvil which is of reduced size below the head; (j) the arm of a crank extending from the wrist to the shaft."

We are dealing here with a piston which is a machine structure analogous to a beam, rail or a crank, in which piston the web was described as "extremely rigid".

We have not here a web, but a piston having a web. Inherently such a web may be flexible, but again it may not be flexible under the forces permissible to prevent seizure of the piston in the cylinder. When it is therefore described as extremely rigid, it naturally means that it is rigid and

not flexible under the conditions to be ordinarily encountered.*

When, therefore, Gulick originally described the web of the piston as being "extremely rigid" those skilled in the art were told that it was to be made of such dimensions as to be rigid under the pressures permissibly active upon it in a cylinder. To so function it had a definite mode of operation by virtue of the rigidity of the web. When the specification was therefore amended to describe the web as "laterally flexible", there was introduced not only another structure, but another mode of operation.

This case, therefore, does not involve the disclosure of an element with an amendment describing the inherent property of that element as contended by respondents' counsel. The element originally described was not simply a "web", but "an extremely rigid" web, and by amendment this was

* The above explains the statements by both Jeffries and Stelman quoted in respondents' brief (p. 32). Both were considering inherent flexibility. Stelman was, of course, "looking at the drawings", but he had qualified his statement quoted by respondents' counsel by testifying (R. 568):

"Q. Anybody understanding pistons and skilled in the piston art would know those webs would be flexible if made of the material of which pistons are ordinarily made? A. Yes, if they were not tied down in any way as shown in this piston."

Furthermore on redirect he testified:

"Q. Is it your idea that the expression 'extremely rigid' means the same as 'very flexible'? A. I should not think so, no."

"Q. As a matter of fact, those expressions are as wide apart as the poles, aren't they? A. Diametrically opposed, I should say" (R. 577).

* * * * *

"A. He describes a very rigid section between the wrist pin bosses and the skirt of the piston, designated by 17 and 18 in Fig. 4."

"Q. Would that convey to your mind that the structure was intended to be very flexible? A. No, sir, I should say that he intended that it should be rigid" (R. 578).

changed to a "laterally flexible" web. They are not the same element, but are different elements, indeed, they are diametrically different in essential structure, function and mode of operation.

Respondents' brief, proceeding on the assumption that a patent is a contract, draws the rather ridiculous analogy that if there was a contract for a cow, it would not be necessary to specify that the cow was to have various vital organs. The difficulty with this argument is that a patent, although in certain respects a contract, must nevertheless contain "a written description of the" invention, and "of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same" (§ 4888); and this Court has held that a deficiency of the specifications in any of the above respects may not be supplied by drawings (*Permutit v. Grover*).

(4) We have already shown how the decision in *Permutit v. Grover*, destroys the "inherent flexibility" argument, and, in our main brief, have pointed out that under that decision, the absence in the original specification of the element of lateral flexibility cannot be supplied by reference to the drawings on which respondents' expert relied. Respondents contend, however, that there is a difference between supplying an essential element of an invention which is missing in the specification of an issued patent and permitting an application to be thus amended in the Patent Office. We submit that there is no such difference when it is borne in mind that new matter can never be inserted in an appli-

eration.* As drawings may not be resorted to "where there is an entire absence of description of the alleged invention";** it was certainly new matter to insert in this application that the webs were laterally flexible, especially when they had been previously described as "extremely rigid". We have previously shown that the alleged "inherent flexibility" has no substantial basis. We submit, therefore, that it can make no difference, so far as the applicability of *Permutit v. Graver* is concerned, whether we are dealing with a pending application in the Patent Office or an issued patent.

Here as in *Powers-Kennedy v. Concrete Co.* the patentee lifted the finally claimed invention out of the application of the other man (Hartog). While Gulick was not in the Hartog-Pomeroy interference, respondent became familiar with the Hartog claim, as stated by respondent (R. 1875), and copied ("lifted") it (R. 1872). It is immaterial whether the Pomeroy application was then owned by Aluminum Company of America, although Jeffries shows that Pomeroy was then associated with that Company's predecessors (R. 185),

*The rule is stated by the Circuit Court of Appeals for the Eighth Circuit in *Insulite Co. v. Reserve Supply Co.*, 60 F. (2d) 433, 435, as follows:

"While it is permissible during the prosecution of an application for a patent, to make amendments to the specifications and claims, yet these amendments must be directed to the same invention as originally disclosed, rather than to new matter".

In *Gardner v. Herz*, 118 U. S. 180, this Court held, to quote from the syllabus:

"The suggestion in the second reissue, that 'the seat is adapted to be secured to any chair frame, as it is easily cut and fitted to the same', not being found in the original patent or in the first reissue, is new matter, and does not confer patentability on the article. No ground for patentability can be derived from the insertion of such matter in suggestions in the second reissue".

** *Permutit v. Graver*, 284 U. S. 60.

and it is a fact that the Pomeroy patent thereafter issued to respondent (R. 1803). Long was actively adverse from 1917 to at least April, 1924, when the trust estate was formed, after which, probably 1926, he stopped making pistons, as the trust estate then had the broad Spillman & Mooers and Franquist patents and had sued Long on the former (petitioner's brief, p. 7).

There were intervening rights of Long and Hartog, by the latter exactly as in the *Powers-Kennedy* case, where the MacMichael interests had purchased the Leake application, and both patents were issued to the MacMichael interests (see petitioners' brief, p. 25). The fact that petitioner was not involved is immaterial because in a situation involving adverse rights, the adverse rights of the general public are paramount, *Macbeth Evans Co. v. General Electric Co.*, 231 F. 183, 189 (Aff'd. 246 F. 695, C. C. A.—6), cited with approval by this Court in *Woodbridge v. United States*, 263 U. S. 50. Indeed it was really so held by this Court in the *Powers-Kennedy* case.

Respondents' counsel also says that no broadening took place, because claim 1 as filed was broader than what the Court of Appeals found was the invention of the Gnlick patent.

Of course, if the flexible web was an essential element of the patent as the Circuit Court of Appeals held, it must be read into claim 1, for it is perfectly clear from the Court of Appeals decision that claim 1, without that element, would have been held invalid. It contains only the very elements which the Court of Appeals said would not involve invention over the prior art. But we are not concerned with whether there was a broadening of the invention or not. Rather the question is whether an essential element of a combination which the Court of Appeals held constituted patentable in-

vention was described in the original application in such a way that it could be *specifically* added, even when apparently contrary to the original disclosure, five years after another device containing all of the elements of the combination was on the market. *Powers-Kennedy v. Concrete*, and the cases which it followed, we submit, require a negative answer.

We are not concerned here with a broadening of any claim so as to include a piston having no web, because the Court of Appeals held that pistons which did not include any web, even though including a T-slot, did not infringe either the Gulick or the Maynard patents (R. 2394).

Point II.

Respondents attempt to answer our Point II by taking issue with our contention that the Court of Appeals found flexible webs an essential element of the Maynard patent. This respondents attempt to do by laying emphasis on the words "the regions of the wrist pin bosses". The language used by the Circuit Court of Appeals was "flexible webs in the region of the wrist pin bosses". This was but another way of saying "webs laterally flexible". The Court of Appeals said (the full quotation being on page 36 of our main brief) that the Maynard patent embodied the Gulick combination, one element of which was webs laterally flexible. Again it said:

"It is clear that Maynard, while not departing from the teaching of Gulick in *basic combination of elements*, discloses a piston lighter and more economical of manufacture than Gulick and one more rugged and durable than Jardine" (R. 2393).

The invention over Gulick and Jardine was apparently found in *details* of construction, but one of the essential elements was the laterally flexible webs; necessarily so because of the prior Franquist, Schmiedeknecht and Long pistons (see our main brief). As these webs are neither described in the specifications nor mentioned in the claims, and can only be found by reference to the drawings or by reason of the "inherency" argument which we have discussed in connection with the Gulick patent, it follows that the Maynard patent is invalid under § 4886 in the light of *Permutit v. Graver*.

Petitioner's expert Stellman did not admit "extensive commercial use of the precise piston illustrated in the drawings of the Maynard patent" as stated by respondents (brief p. 49). He testified as to "general design" of such pistons, not the "precise piston". We have shown that no piston like Exhibit 1 was on the market that did not have the Keystone relief. Respondents' drawing of the Maynard patent piston (brief p. 52) does not show the Keystone relief and the Master found (R. 1162) that the Maynard patent did not disclose it in either the specification or the drawing, and this is based on the admission of respondents' expert Jeffries (R. pp. 130, 225). Indeed, the Keystone relief was not put on the piston until 1925, four years after Maynard filed (Exhibit 22, Vol. III, p. 1339).

Point III.

The Long pistons are belittled by respondents' counsel in spite of the fact that they were the only pistons compensating for expansion in commercial use before 1923 when the alleged piston of the Maynard patent is supposed to have first appeared. We do not have to rely upon any of

petitioners' evidence for this, because we have the testimony of respondents' own witness that they were in commercial use in the Franklin automobile as early as 1920 (see petitioner's brief, p. 45).

Not only were these pistons in use in the Franklin automobile, but they were in use in the replacement trade, in addition to Franklin automobiles in the Oldsmobile, Northway, Ford, Essex, Duesenberg, and Reo (R. 392 and 412), and exhibits (R. 1613, 1615, 1617 and 1619). The Franklin engine was the worst possible engine that an aluminum piston could be used in, because it was air cooled, and Stellman shows that (R. 458). Furthermore, the Long piston was not replaced in 1926 by any piston of the Maynard patent, or even by Exhibit 1 having the Keystone relief, but by a strut piston (see petitioners' brief, p. 45).

What Should Be Remanded to the Court Below for Decision.

Respondents contend (Br. p. 77) that if this Court should reverse the Court of Appeals, it should remit to that Court for decision the questions arising upon the patents in suit other than Gulick and Maynard, as well as certain claims of the latter patents. If it is proper to remit to the Court of Appeals for decision the questions in respect to the patents not passed upon, even though the Court of Appeals apparently considered them of little worth (see our main brief, p. 4), we submit that respondents should not be afforded another opportunity to have the Court of Appeals pass upon other claims of the Gulick and Maynard patents than those specifically referred to in the mandate (R. p. 2379). In the first place, the Circuit Court of Appeals' holding as to what constituted invention in both

patents necessarily requires the reading into all of the claims of each patent "webs laterally flexible". In the second place, respondents picked out for the Court of Appeals certain example or typical claims for it to pass upon (see petitioners' brief in Court below, p. 74). *Great Northern Co. v. General Electric Signal Co.*, 57 F. (2d) 457, 461-463 (C. C. A. 8th, Cert. den. 283 U. S. 895).

Respectfully submitted,

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